Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH RITTNER
and
HEINER SCHMIDT

Appeal No. 2000-1984
Application No. 08/565,775

ON BRIEF

Before KRASS, DIXON and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that part of our decision of June 18, 2002 wherein we sustained the rejection of claims 1-16 and 21-23 under 35 U.S.C. § 112, first paragraph, and the rejection of claims 1-3 and 5-10 under 35 U.S.C. § 102(b) over Schweizerhof.

With regard to the rejection under 35 U.S.C. § 112, first paragraph, we held that there was inadequate support for the carrier specified as being of a "non-ferrite material," as is now claimed. Appellants allege that since the specification indicates that the invention is advantageously used in hybrid or multichip modulator technology and appellants have argued that in such technologies a ferrite carrier is never used, it follows that a non-ferrite carrier must be used because this is the opposite of a ferrite carrier.

It appears to us that what appellants are stating as the obvious is that these technologies have a planar carrier that is made of an electrically insulating material. But since both ferrite and non-ferrite materials may have insulative properties, which is not disputed by appellants (see reply brief, page 2), the carrier, as originally disclosed by appellants, need not necessarily be made of non-ferrite material to be insulative. Accordingly, the originally filed disclosure does not reasonably convey to the artisan that the inventors had possession at that time of the now-claimed "non-ferrite carrier."

Appellants now contend that claim 11, and the claims dependent thereon (claims 12-16), should not have been rejected under 35 U.S.C. § 112, first paragraph, because independent

claim 11 recites only a "flat carrier" and not a "flat non-ferrite carrier."

Normally, since this is a new argument, not made earlier in the briefs, it would not be considered at this point. However, since the claims clearly do not recite a "non-ferrite" carrier and the examiner's whole rationale under 35 U.S.C. § 112, first paragraph, is that there is no support in the original specification for a "non-ferrite carrier," we will permit this argument and find for appellants, reversing our earlier decision as to the rejection of claims 11-16 under 35 U.S.C. § 112, first paragraph.

At page 3 of the request for rehearing, appellants make the creative argument that since original claim 1 was directed to a "flat carrier" that encompasses both ferrite and non-ferrite insulative material, appellants were certainly permitted to limit the scope of their claims by limiting the claims to a "non-ferrite carrier." The problem with this argument is that while this may limit the scope of the claims relative to the prior art, the claims have now been limited to an embodiment (non-ferrite carrier) for which there is no adequate support in the original disclosure, running afoul of the written description requirement of 35 U.S.C. § 112.

With regard to the prior art rejection, appellants argue that Schweizerhof does not anticipate claims 1-3 and 5-10. While not giving a specific argument to any particular claim limitations, appellants contend that we failed to follow the guidelines of Gechter v. Davidson, 116 F.3d 1454, 43 USPQ2d 1030, (Fed. Cir. 1997) which mandates specific findings of fact by the PTO.

Appellants refer to an earlier amendment after final to argue two limitations set out in claim 2 vis-à-vis the Schweizerhof patent. Similarly, appellants refer to that amendment for argued limitations of claims 5-10.

Despite whatever arguments may have been made earlier in the prosecution of the case, we consider appellants' briefs to be complete in their arguments against the examiner's position. Therefore, we have only considered arguments appearing in the briefs, arguments not repeated therein being treated as waived.

Since, on review, we find that appellants did, in fact, argue the limitations of claim 2 (principal brief, page 17), of claim 6 (principal brief, page 18) and, generally, of claims 5 and 7-10 (principal brief, page 19), we will entertain appellants' arguments in the request for rehearing.

With regard to claim 2, appellants argue that Schweizerhof does not show a "hollow" window frame that is "stuck onto the carrier" wherein the window frame lies "entirely within the border of the flat carrier." We disagree. The "window" in Schweizerhof is element 10, not 15, as argued by appellants at page 17 of the principal brief. This window is clearly "hollow," as claimed. Further, we agree with the examiner that it is "stuck" onto the carrier in the sense that it does not fall off the carrier. If "stuck" has some special meaning, it is not pointed out by appellants nor does the claim indicate any such meaning. Clearly, from Figure 2 of the reference, the window 10 is "entirely within the border" of the carrier, which is relatively flat.

Appellants argue that with respect to claims 5 and 7-10, which recite that at least one of insulant window alignment, insulant window contour, ferromagnetic material layer height and ferromagnetic material composition is chosen so as to determine at least one coil parameter including at least one of inductance and coupling of the spiral-shaped coil, the examiner has made a self-serving allegation that "every inductor has height, contour, shape, material, etc. chosen to achieve a specific inductance." However, we agree with the examiner that, based on the breadth of

these claims, all that is required is that at least one of a variety of parameters is chosen to determine coil inductance. Clearly, artisans knew that any one of these recited parameters affects the inductance of the coil and appellants offer no dispute as such. While appellants state that our decision does not address "the contested limitations of claims 5 and 7-10" (request for rehearing, page 5), it is unclear what, exactly, are the "contested limitations."

Turning, finally, to claim 6, appellants state that they contested certain features of this claim at page 18 of the principal brief. In particular, appellants argued that the examiner did not address the claimed feature of a ferromagnetic material that fills the window frame and covers the carrier but not the insulant window frame. However, the examiner did address this limitation, at page 12 of the answer, by stating that, in Schweizerhof, the ferromagnetic material is inside frame 15. While appellants refer to other references when arguing the examiner's rationale with regard to claim 6, appellants do not address, or argue, the examiner's contention, with regard to Schweizerhof, that the ferromagnetic material is inside frame 15. Arguments not made are waived. In re Kroekel, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

We have reviewed our decision in view of appellants' request for rehearing. As a result of that review, we have granted appellants' request with respect to reconsideration, and we have granted appellants' request with regard to reversing ourselves regarding the rejection of claims 11-16 under 35 U.S.C. § 112, first paragraph. However, we deny appellants' request with respect to making any other changes in our decision.

Accordingly, our decision of June 18, 2002 is amended to sustain the rejection of claims 1-10 and 21-23 under 35 U.S.C. § 112, first paragraph, to sustain the rejection of claims 1-3 and 5-10 under 35 U.S.C. § 102(b) over Schweizerhof, to not sustain the rejection of claims 11-16 under 35 U.S.C. § 112, first paragraph, to not sustain the rejection of claims 1-3 and 5-10 under 35 U.S.C. § 102(b) over Kosha, Lindner, Grader or Richardson, to not sustain the rejection of claim 4 or claim 23 under 35 U.S.C. § 102(b), to not sustain the rejection of claims 1-16 and 21-23 under 35 U.S.C. §102(b) over Astle and to not sustain the rejection of claims 5, 7-9 and 15 under 35 U.S.C. § 112, second paragraph.

Accordingly, the examiner’s decision is now denoted as being affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, GRANTED-IN-PART

ERROL A. KRASS Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

EAK:clm

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